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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,222	05/09/2001	Roger Alcala	3109/1G960 US1	4229

7590 03/28/2005  
DARBY & DARBY P.C.  
805 Third Avenue  
New York, NY 10022

EXAMINER
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FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/852,222

Applicant(s)

ALCALY ET AL.

Examiner

Daniel S Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Receipt of the amendment filed December 23, 2004 amending claims 1, 3 and 22 are acknowledged. Claims 1-33 remain pending in the application and are presented to be examined upon their merits.

#### ***Response to Arguments***

2. Applicant's arguments filed December 23, 2004 have been fully considered but they are not persuasive.

#### **Regarding rejections under 35 USC § 101:**

The rejections of claims 1, 3, 14, 20, 22 and 24 set forth in the previous Office Action are maintained. The mere recitation of technology (i.e., a computer) in the preamble, without any further tie to technology in the body of the claim that would provide technology in a non-trivial manner to the claimed subject matter does not breath "life and meaning" into the claim and thus, does not constitute a limitation. [see *Kropa v. robie*, 88 USPQ 478 (CCPA 1951).] Since the preamble does not constitute a limitation and the body of the claim provides for no technology, the claimed invention lacks technology. Moreover, like the analysis provided earlier, the invention in the body of the claim manipulates an Abstract idea without producing a "useful, concrete and tangible result"-i.e., generating an index.

**Regarding rejections under 35 USC § 103(a):**

The applicant has amended claim 1 most significantly out of all the other claims. in the preamble of *fundamental* investment returns *in asset classes, including commercial asset classes....* (b) *for any time t including present time, time t being at the close of a holding period h*, generating a rule *based on market prices at a plurality of times preceding time t* to determine a position for each of said assets for *a succeeding holding period h+1*... (c ) determining the position for each of said assets for said *succeeding holding period h+1 in accordance with said rule*; (d ) *obtaining* market prices for each of said assets *at the beginning and end of succeeding holding period h+1*... (e) computing a return for each of said assets for said *succeeding hold period h+1* said return being a function of the position for said succeeding holding period h+1 and the market prices at the beginning and end of said succeeding holding period h+1 determined in steps (c ) and (d).

Melnikoff discloses a portfolio selector for selecting an investment portfolio from a library of asset based upon investment risk and risk adjusted return (see Abstract). Melnikoff also indicates that the invention can be applied to all types of investment (i.e., mutual funds) (see col. 7, ll. 29-63). It is well known within the art that various assets (i.e., bonds) have various holding periods as well as rules that are inherent in such assets which govern how long the asset is held for. The market usually sets the price for these assets. Thus Melnikoff discloses the aforementioned amendment via the use of various assets and T-bills at varying time periods and holding times which are inherent with such assets. Thus rejections made under 35 USC § 103(a) are maintained.

***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF

March 17, 2005

Daniel S Felten  
Examiner  
Art Unit 3624

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